REMARKS

Applicant respectfully requests further examination and reconsideration in view of the instant response. Claims 1-20 remain pending in the case. Claims 1-20 are rejected. Claims 1, 3, 18 and 20 have been amended to provide proper antecedent basis. No new matter has been added. The Examiner is thanked for performing a thorough search.

Applicant respectfully points out that although Claims 1, 3, 18 and 20 were amended, it would be improper to make the next Office Action final if Applicant's arguments are found persuasive since Claims 1, 3, 18 and 20 were not amended in a way that would cause a new search to be performed.

CLAIM OBJECTIONS

The Office Action objected to Claim 3 due to an informality. The Office Action states, "The term 'said addition' in line 2 of claim 3 lacks antecedent basis." Applicant has amended Claim 3 to provide proper antecedent basis. Therefore, Applicant believes that this objection has been addressed.

35 U.S.C. §103(a)

Claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent Application Publication 2004/0243534 by Cutler et al., (hereinafter referred to as "Cutler") in view of "ACPI System Locality Information Table Interface Version 0.9 by Hewlett Packard (hereinafter referred to as "ACPI Cited Art"). Applicant has reviewed the cited art and respectfully submits that the embodiments recited by the instant application serial no. 10/777,438 are neither taught nor suggested by Cutler or ACPI Cited Art, alone or in combination.

Applicant respectfully submits that "[i]t is improper to combine references where the references teach away from their combination" (emphasis added; MPEP 2145(X)(D)(2); *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). Applicant respectfully notes that "[a] prior art reference must be considered in its

entirety, i.e., as a <u>whole</u>, including portions that would lead away from the claimed invention" (emphasis in original; MPEP 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). Further, Applicant respectfully submits that, "[w]ith regard to rejections under 35 U.S.C. 103, the examiner must provide <u>evidence which as a whole shows</u> that the <u>legal determination</u> sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) <u>is more probable than not</u>" (emphasis added) (MPEP 2142).

In particular, "if the proposed modification or combination of the prior art <u>would change the principle of operation</u> of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious" (emphasis added) (MPEP 2143.01(VI); *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Further, "[i]f the proposed modification would render the prior art invention being modified <u>unsatisfactory for its intended purpose</u>, then there is no suggestion or motivation to make the proposed amendment" (emphasis added) (MPEP 2143.01(V); *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

More specifically, Applicant respectfully submits that there is no motivation to combine the teachings of Cutler and ACPI Cited Art, because various combinations of the cited art <u>teach away from</u> the suggested modification. For example, Applicant understands the combination of Cutler and ACPI Cited Art to change each other's principles of operation, or to render each others' teachings unsatisfactory for their intended purposes, or a combination thereof as will be described in more detail.

CUTLER

This section describes Applicant's understanding of what Cutler teaches. Applicant understands Cutler to teach autonomously and dynamically generating an ACPI table entry that includes any added AML code therein for supporting a hardware element C that has been added (0039). An agent 207 accesses a database 206 and

utilizes device-specific properties stored in the database 206 for hardware element C to generate any AML code that supports hardware element C (0039). The composite pattern of information stored in the database 206, 605 resembles a tree, and therefore the database 206, 605 is referred to as a "Device Tree" (0074).

ACPI CITED ART

This section describes Applicant's understanding of what the ACPI Cited Art teaches. The ACPI Cited Art states in the fourth and fifth paragraphs under the second section entitled "System Locality Information Table Definition,"

> The SLIT can be viewed as a <u>matrix</u> of distances, with row I of the matrix indicating the distance from locality I to every locality (including itself). Each table entry is a 1-byte unsigned integer. To get the distance from locality i to locality j, read the i*(Localities)+j entry in the <u>matrix</u>. Except for the distances from the locality to itself, each distance is stored twice in the <u>matrix</u>.

> What this means is that the diagonal elements of the <u>matrix</u>, the distances from the locality to itself, which are the SMP distances, are all given a value of 10. The distances for the non-diagonal elements are scaled to be relative to the SMP distance, so, for example, if the distance from locality i to locality j is 2.4 times the SMP distance, a value of 24 would be stored in table entry i*(localities)+j and in j*(localities)+i (emphasis added).

THE COMBINATION OF CUTLER AND THE ACPI CITED ART

This section describes why Applicant believes that Cutler and ACPI Cited art teach away from each other and therefore they cannot be combined to render the embodiments recited by the instant application obvious. Cutler uses a "Device Tree." ACPI Cited Art uses a matrix. Modifying Cutler to use a matrix instead of a device tree or modifying ACPI Cited Art to use a device tree instead of a matrix would change their principles of operation and would render them unsatisfactory for their intended purposes.

SUMMARY

For at least the reasons that Applicant believes that Cutler and ACPI Cited Art teach away from each other, Applicant respectfully submits that Cutler and the ACPI

cited art cannot be combined to render the embodiments recited by the instant application serial no. 10/777,438 obvious.

CONCLUSION

Based on the arguments presented above, Applicant respectfully asserts that Claims 1-20 overcome the rejections of record and, therefore, Applicant respectfully solicits allowance of these Claims.

The Examiner is invited to contact Applicant's undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

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